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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,370	07/06/2001	Noboru Takada	33781	6021

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EXAMINER

AGGARWAL, YOGESH K

ART UNIT PAPER NUMBER

2615

DATE MAILED: 10/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/900,370

Applicant(s)

TAKADA ET AL

Examiner

Yogesh K. Aggarwal

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7,9-17 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7,17 and 19-21 is/are allowed.
- 6) ☒ Claim(s) 9-14 is/are rejected.
- 7) ☒ Claim(s) 15,16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Arguments

1. Applicant's arguments with respect to claim 9 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flom et al. (US Patent # 4,641,349) in view of Cambier et al. (US Patent # 6,532,298).

[Claim 9]

Flom et al. teaches an iris camera module (figures 8-10) comprising an image pickup optical system (82, 82a 76, 74) for picking up an image of the iris of a user (col. 8 lines 1-14, col. 8 lines 25-40) and a target optical system including a target screen (target screen 71 shown in figure 8 and also shown a viewing screen 86 for the iris camera 84 in figure 9) for displaying a target for aligning the eye of the user (col. 8 lines 10-40, col. 8 lines 64-68, col. 9 lines 27-41, col. 9 line 59- col. 10 line 2, col. 10 lines 15-28, figures 9 and 10).

Flom et al. fails to teach wherein the target optical system and the image pickup optical system are integrated onto a common substrate.

However Cambier teaches a compact, handheld imaging apparatus, which can be used to capture iris images for identification of a person. Cambier further teaches a housing material of

Art Unit: 2615

element 700 as depicted in Fig. 9A is a common substrate to the image pickup optical system and the target optical system. Further, the telephone 575 depicted in Fig. 9A is a common substrate to the image pickup optical system and the target optical system (col. 13 lines 19-44, also shown that the imager and phone circuitry 870 being encased within the device 800, figures 9b-9d)

[Examiner notes that Applicant has never defined what the common substrate is in the specification. In particular, Examiner notes that the support of this claim is derived from substrate 50 illustrated in Figs. 2 and 10 of the instant invention, however, there is no discussion as to what substrate 50 is. Furthermore, the term substrate as is commonly used in the art refers to electrical components etched on a material like silica. Lenses and other optical components **cannot** be integrated on a substrate. Therefore, the term substrate as used in the specification refers to a housing or any base material on which the image pickup optical system and the target optical system are mounted].

Therefore taking the combined teachings of Flom and Cambier, it would be obvious to one skilled in the art at the time of the invention to have been motivated to have the target optical system and the image pickup optical system integrated onto a common substrate in order to have a compact, handheld imaging apparatus which can be used to capture good quality iris images for identification of a person.

[Claim 10]

Cambier discloses an iris camera module according to claim 9, wherein the image pickup optical system includes an infrared illuminating section for irradiating an infrared ray onto the eye (e.g., element 130 of Fig. 8; column 4, lines 25-57); an image pickup section for picking up the image of the iris by detecting the infrared ray reflected on the eye (e.g., element 105 of Fig. 8); and an

Art Unit: 2615

image pickup optical section for guiding the infrared ray reflected on the eye to the image pickup section (e.g., element 110 of Fig. 8), and further wherein the target optical system includes: a target optical section for guiding the image of the target on the target screen to the eye (e.g., element 120 of Fig. 8; column 4, lines 52-62).

[Claim 11]

In regards to claim 11 see Examiner's notes on the rejection of claim 10. Examiner notes that Cambier discloses another embodiment for implementing the imager 101 as depicted in Fig. 2B wherein it is well within the skill of one skilled in the art to select one of the two functional equivalents of Fig. 2B or Fig. 8. As such, the image pickup optical section and the target optical section include a common half mirror (e.g., element 121 of Fig. 2B) for reflecting to guide the infrared ray reflected on the eye to the image pickup section and guiding the image of the target screen on the target screen to the eye without reflecting the image.

[Claim 12]

In regards to claim 12 see Examiners notes on the rejection of claim 11. Examiner notes that it would have been obvious to one skilled in the art to have placed element 122 where elements 111 and 106 are located in Fig. 2B and vice versa, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Further, Examiner notes that it would have been obvious to one skilled in the art to have placed element 122 where elements 111 and 106 are located in Fig. 2B and vice versa, since it has been held that a mere reversal of essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

[Claim 13]

Art Unit: 2615

Cambier discloses an iris camera module according to claim 9, wherein the target optical system includes a screen illuminating section for illuminating the target screen (e.g., element 130 of Fig. 8).

[Claim 14]

Cambier discloses an iris camera module according to claim 10, wherein the image pickup section further includes an image pickup element for picking up the image of the iris (e.g., element 105 of Fig. 8); a storage for storing a reference iris information (e.g., element 530 of Fig. 8; column 12, lines 58-60); and a comparator section for comparing an information based on the image of the iris picked up by the image pickup section with the reference iris information to output the comparison result as to whether matching is obtained (e.g., element 500 of Fig. 8; column 12, lines 50-52).

Allowable Subject Matter

4. Claims 7, 17, and 19-21 are deemed allowable over the prior art of record. See the reasons for allowance in the Office Action mailed on June 18, 2004.
5. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. The reasons for allowance for claim 15 is substantially similar to the reasons for allowance for claims 7, 17, and 19-21.
7. In regards to claim 16 the prior art of record does not disclose nor fairly suggest the combination of limitations recited in claim 16 and the claims from which it depends wherein the image pickup section includes an image pickup element for picking up the image of the iris, a

Art Unit: 2615

connector section for coupling an external circuit detachable from the image pickup section, wherein the external circuit includes a storage for storing a reference iris information, and a comparator section for comparing an information based on the image of the iris picked up by the image pickup section with the reference iris information to output the comparison result as to whether matching is obtained.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh K. Aggarwal whose telephone number is (571) 272-7360. The examiner can normally be reached on M-F 9:00AM-5:30PM.


8. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Ometz can be reached on (571)-272-7593. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Art Unit: 2615

YKA

October 12, 2005


DAVID L. OMETZ
SUPERVISORY PATENT
EXAMINER